

REMARKS

This Amendment and Response is submitted in response to the Office Action mailed 25 SEPTEMBER 2003. Withdrawal of the rejection and reconsideration with an eye toward allowance is respectfully requested.

Claim Status

Claims 1-40 are pending after entry of the present amendment. Claims 1-37 stand rejected, claim 38 is objected to, and claim 39 is indicated as being allowable. Claims 1, 20, and 31 are amended herein. Claim 40 is added herein. A complete listing of all claims that are, or were in the application, along with an appropriate status identifier, is provided above in the section entitled "Amendments to the Claims". Markings are provided on claims amended in the present amendment.

Support for the above claim amendments can be found throughout the originally filed specification, drawings, and claims.

Abstract

The Examiner objected to the abstract. Applicant has amended the abstract as indicated above, and trusts that the amendment removes the objection.

Claim Rejections – 35 U.S.C. §101

Claims 1-37 were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

Without admitting the propriety of the rejection, Applicant has amended independent claims 1, 20, and 31 to include the limitations "loading a plurality of input coefficients into at least one register" and "shifting the input coefficients left a plurality of bits". These limitations further appear in independent claim 39, indicated by the Examiner as being allowable.

Claims 2-19 depend from and include all limitations of independent claim 1. Claims 21-30 depend from and include all limitations of independent claim 20. Claims 32-36 depend from and include all limitations of Applicant's claim 31. Accordingly, Applicant submits that the 35 U.S.C. §101 rejection of claims 1-36 is improper and should be withdrawn.

With regard to independent claim 37, Applicant respectfully submits that the 35 U.S.C. §101 rejection of claim 37 is improper. The Examiner suggests that claim 37 is directed to a non-statutory process. Applicant respectfully submits that Claim 37 is directed toward a statutory apparatus, and recites several 'means for' limitations. Applicant notes that 35 U.S.C. §112, paragraph 6 states that "An element in a claim for a combination may be expressed as a means or step for performing a specified

function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

Applicant respectfully draws the Examiner's attention to *In re Alappat*, 31 USPQ2d 1545 (CA FC 1994). In this case, an Applicant presented a claim to a rasterizer, containing various claim limitations recited in a "means for" format. The court concluded that the means-plus-function claim, when properly construed claimed a rasterizer "made up of, at the very least, the specific structures disclosed in Alappat's specification corresponding to the means-plus-function elements (a)-(d) recited in the claim." Further, the court stated that, "because claim 15 is directed to a 'machine', which is one of the four categories of patentable subject matter enumerated in section 101, claim 15 appears on its face to be directed to Section 101 subject matter" see *In re Alappat*, 1555.

Alappat's claim 15 had been rejected, stating that it was directed to mathematical subject matter. The Court stated that "the proper inquiry in dealing with the so called mathematical subject matter exception to Section 101 alleged herein is to see whether the claimed subject matter as a *whole* is a disembodied mathematical concept, whether categorized as a mathematical formula, mathematical equation, mathematical algorithm, or the like, which in essence represents nothing more than a 'law of nature,' 'natural phenomenon,' or 'abstract idea'. See *In re Alappat*, 1557, emphasis in original. The Court found that "Although many, or arguably even all, of the means elements recited in claim 15 represent circuitry elements that perform mathematical calculations, which is essentially true of all digital electrical circuits, the claimed invention as a whole is directed to a combination of interrelated elements which combine to form a machine for converting discrete waveform data samples into anti-aliased pixel illumination intensity data to be displayed on a display means. This is not a disembodied mathematical concept which may be characterized as an 'abstract idea', but rather a specific machine to produce a useful, concrete, and tangible result." see *In re Alappat*, 1557.

In the present application, Applicant submits that claim 37 is directed toward an apparatus for producing a useful, concrete, and tangible result. Applicant further submits that claim 37 should be construed to claim at least an apparatus made up of the structures disclosed in Applicant's specification. See for example, page 6 and Figure 1, as well as claim 38, disclosing a processor used to implement the invention.

Accordingly, Applicant submits that the 35 U.S.C. §101 rejection of claim 37 is improper, and should be withdrawn.

Allowable Subject Matter

Although not specifically stated in the office action, Applicant notes with appreciation the Examiner's finding of allowable subject matter in claim 39, as indicated in the Office Action summary. Further, the Examiner's objection to claim 38 is noted in the Office Action summary, although no objection is articulated in the body of the office action. For the purposes of response, Applicant has interpreted this

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objection as the Examiner's having found allowable subject matter in dependent claim 38, dependent on rejected claim 37.

New Claims

Applicant has added new claim 40 directed to a method for decompressing a compressed signal, including claim limitations found in allowable claim 39. Accordingly, Applicant submits that new claim 40 is allowable.

CONCLUSION

Applicant submits the claims are in condition for allowance, and notification of such is respectfully requested. If after review, the Examiner feels there are further unresolved issues, the Examiner is invited to call the undersigned at (415) 781-1989.

Respectfully submitted,
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